



ORIGINAL

PATENT
Atty. Docket No.: Le A 33 820

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Cheung, *et al.*

SERIAL NO.: 09/743,827

FILING DATE: January 16, 2001

TITLE: Antiparasitic Artemisinin Derivatives (Endoperoxides)

PETITION, FEE AND STATEMENT OF FACTS SUPPORTING A FILING
ON BEHALF OF NON-SIGNING INVENTOR UNDER 37 C.F.R. § 1.47(a)

Commissioner for Patents and Trademarks
Washington, D.C. 20231

Sir:

This Petition is made in accordance with 37 C.F.R. § 1.47(a) in the above-captioned application in support of filing on behalf of William Wai-Lun Lam, a co-inventor of the claimed subject matter. Applicants have made diligent efforts, as described below and in the attached Declaration of Richard Haynes, to obtain the signature of Mr. Lam on the enclosed Combined Declaration and Power of Attorney. Applicants therefore request that they be allowed to file the instant application without Mr. Lam's signature.

The instant application was originally filed in the EPO on July 14, 1998 on behalf of the Hong Kong University of Science and Technology (HKUST). Bayer AG, D 51368 Leverkusen, Germany, subsequently obtained rights in the invention disclosed and claimed therein. An assignment to Bayer AG from all inventors, except Mr. Lam, was executed. In preparation for filing the application in the U.S., the Assignee sought to

obtain signatures on the Combined Declaration and Power of Attorney form from the inventors with the aid of the HKUST. Mr. Lam's last known address is

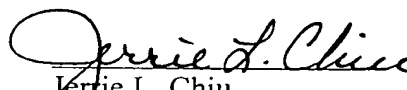
102, Hongo 5-6-6, Bunkyo-ku, Hongo, Tokyo, Japan, 113

but Mr. Lam is no longer residing at that address. Representatives of HKUST contacted Mr. Lam's last known employer, namely the University of Tokyo. The University of Tokyo did not have a forwarding address for Mr. Lam. Representatives from the HKUST then contacted Mr. Lam's parents on multiple occasions to inquire as to the current address and/or telephone number of Mr. Lam. On all such occasions, Mr. Lam's parents claimed not to have such information.

Applicants therefore submit that diligent efforts to obtain the signature of Mr. Lam were made and request that they be permitted to submit the attached Declaration without Mr. Lam's signature. Please charge all fees due with this petition, including those specified under 37 C.F.R. § 1.17(h), to deposit account number 13-3372.

Respectfully submitted,

Dated: July 24, 2001
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516
(Tel) (203) 812-3964
(Fax) (203) 812-5492
e-mail: jerrie.chiu.b@bayer.com


Jerrie L. Chiu
Attorney for Applicants
Reg. No. 41,670



PATENT
Atty. Docket No.: Le A 33 820

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Cheung, *et al.*

SERIAL NO.: 09/743,827

FILING DATE: January 16, 2001

TITLE: Antiparasitic Artemisinin Derivatives (Endoperoxides)

**DECLARATION OF RICHARD HAYNES IN SUPPORT OF A FILING
ON BEHALF OF NON-SIGNING INVENTOR UNDER 37 C.F.R. § 1.47(a)**

Commissioner for Patents and Trademarks
Washington, D.C. 20231

I, Richard Kingston Haynes, of House 2, 1 University Road, Hong Kong University of Science and Technology, Clear Water Bay, Kowloon, Hong Kong, declare and state that:

1. I am a professor of chemistry at the Hong Kong University of Science and Technology (HKUST), Department of Chemistry, Clear Water Bay, Kowloon, Hong Kong.
2. William Wai-Lun Lam was a post-doctoral research fellow in my research group from September 1996 to June 1998.
3. After Dr. Lam completed work as a post-doctoral research fellow in my group, he moved to the Department of Organic Chemistry at the Imperial College of Science, Technology and Medicine, London, where he worked as a postdoctoral fellow in the group of Professor A. G. M. Barrett for approximately one year. Professor Barrett through his secretary has informed me by Email that he is unaware of the current whereabouts of Dr. Lam.
4. After his time at Imperial College, Dr. Lam then moved to the Graduate School of Pharmaceutical Sciences, Faculty of Pharmaceutical Sciences,

University of Tokyo. I successfully contacted him there via Email on 9th September 1999 over the need to provide a signature for patent filing. His Email address at that time was: chwwll@mol.f.u-tokyo.ac.jp. The postal address he gave was 102, Hongo 5-6-6, Bunkyo-ku, Hongo, Tokyo, Japan, postal code: 113, Phone number 03-3814-3821. The address of the University of Tokyo is: 7-3-1 Hongo, Bunkyo-ku, Tokyo 113-8654, Japan.

5. Dr. Lam appears to be no longer at the address in Japan, as the foregoing Email address is no longer valid. Attempts to obtain information on the whereabouts of Dr. Lam from faculty members within the Graduate School of Pharmaceutical Sciences at the University of Tokyo have also been unsuccessful.
6. Three Cantonese-speaking members of my Department have also been in contact with Dr. Lam's parents in Hong Kong, whose address was 6/F, 100 Shantung St., Mong Kok, Kowloon, Hong Kong. The persons are: Dr. Lam-Lung Yeung, Department of Chemistry, HKUST, Dr. Hing Wo Tsang, Department of Chemistry, HKUST, and Ms. Joanna Yu, Department of Chemistry, HKUST.
7. From January 2001 until the end of March 2001, Dr. Lam's parents indicated verbally in response to phone calls from the foregoing persons that they did not know of their son's whereabouts.
8. At the end of March, Dr. Lam's parents reportedly moved overseas. The new occupants of their apartment have indicated that they do not know where the parents went; they indicated that no forwarding address was left with them or with the local post office. Thus, we have been unable to deliver to Dr. Lam's parents a letter written in both English and Cantonese indicating the importance of obtaining their son's signature.
9. I have contacted current and past members of my research group at HKUST, but they have all indicated to me that they do not know of the whereabouts of Dr. Lam.

Cheung, *et al.*
U.S.S.N. 09/743,827
Page 3 of 3

Dated: 13 July 2001

By: Richard Haynes
Richard Haynes



The U.S. Patent & Trademark Office date stamp hereon will acknowledge receipt of the following in Re the following items filed:

- a) Declaration Of William F. Gray In Support Of A Filing On Behalf Of Non-Signing Inventor Under 37 Cfr § 1.47(A)
- b) Declaration Of Cecilia Scully In Support Of A Filing On Behalf Of Non-Signing Inventor Under 37 Cfr § 1.47(A)
- c) Declaration Of Larry Anderson In Support Of A Filing On Behalf Of Non-Signing Inventor Under 37 Cfr § 1.47(A)
- d) Renewed Petition Under 37 Cfr § 1.47(A)

Return Receipt Post Card.

) Petition For Extension of Time Under 37 CFR 1.136(a)

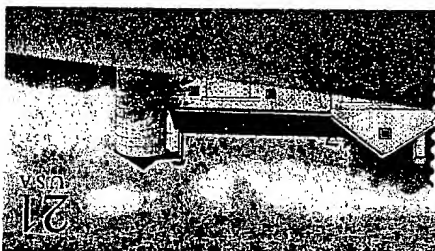
Date of Deposit: 03 July 2002 Docket No. LeA 33 820

First Class Mail or

Express Mail Label No.

Beatriz Alviz
Law & Patents
C32-3B
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516

2000 USPS recycled





Attorney Docket No. Le A33 820

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Cheung, et al.

Serial No.: 09/743,827

Group Art Unit:

Filed: 17 July 1999

Examiner:

Title: Antiparasitic Artemisinin Derivatives (Endoperoxides)

CERTIFICATION OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence and any papers referred to as attached are being deposited, on the date shown below, with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231.

Date:

Eugenia Boshnack
Eugenia Boshnack

Commissioner for Patents and Trademarks
Washington, D.C. 20231

RENEWED PETITION UNDER 37 CFR § 1.47 (a)

Sir:

This is a continuation of the Petition filed by Attorney Jerrie Chiu on 24 July 2001, requesting that the Patent and Trademark Office accept the inventors' declaration in the above-identified Patent Application without the signature of listed inventor William Wai-Lun Lam, who could not be located.

On 4 December 2001, the Patent and Trademark Office issued its decision in response to Atty. Chiu's petition. The petition was dismissed for lack of the requisite factual proof that the missing joint inventor could not be reached after diligent effort.

The decision dismissing the Petition stated that the fee, the statement of the inventor's last known address, and the oath or declaration by the remaining inventors had been received.

As to the factual proof that the missing inventor could not be reached, the decision on the petition indicated that no documentary evidence supporting the failed attempts to reach the inventor had been provided with the declaration of Richard Haynes, which had been submitted in conjunction with Atty. Chiu's original petition, and that it was not

clear from the Haynes' declaration that a complete set of papers were ever sent to Dr. Lam.

A complete set of papers have been sent by me to Dr. Lam at the Hong Kong address shown in the original declaration form. That transmittal is the subject of a separate Declaration by me, accompanying this renewed petition.

The Hong Kong address is the former address of Dr. Lam's parents. Dr. Haynes' declaration of 13 July 2001 detailed the several attempts to obtain Dr. Lam's address from his parents before they moved.

The application and declaration form are also being sent to Dr. Lam's former Tokyo address despite the fact that Dr. Haynes' declaration would appear to establish that this address is no longer valid. This petition will be supplemented when it is determined whether the documents were or were not deliverable to Dr. Lam at the Tokyo address.

Applicants submit that diligent efforts to obtain Dr. Lam's signature on the Declaration have been and are being made, and renew the request that the Declaration without Dr. Lam's signature be accepted.

Respectfully submitted,

3 July '02
Date

William F. Gray
William F. Gray
Attorney for Applicant
Reg. No.: 31018
Phone: (203) 812-2712



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Cheung, et al.
Serial No: 09/743,827
Filed: 17 July 1999
For: Antiparasitic Artemisinin Derivatives (Endoperoxides)

Group Art Unit:
Examiner:

CERTIFICATION OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence and any papers referred to as attached are being deposited, on the date shown below, with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231.

Date:

Eugenia Boshnack
Eugenia Boshnack

**DECLARATION OF WILLIAM F. GRAY IN SUPPORT OF A FILING ON BEHALF OF
NON-SIGNING INVENTOR UNDER 37 CFR § 1.47(a)**

**Commissioner for Patents and Trademarks
Washington, DC 20231**

Sir:

I, William F. Gray, a Patent Counsel at Bayer Corporation, 400 Morgan Lane, West Haven, CT 06516, declare and state that:

1) On June 13, 2002 I arranged to have a copy of the above-identified patent application as well as an appropriate inventorship declaration form sent to:

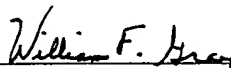
Dr. William Wai-Lun Lam
6/F 100 Shantung Street
Mongkok, Kowloon
HONG KONG

2) The application and declaration were accompanied by a letter written by me to Dr. Lam explaining that he has been identified as an inventor on the patent application and that his signature on the declaration of inventorship is required. I asked that he sign and date the declaration form and return the application and declaration papers as quickly as possible, and also that he fax a copy of the signed declaration to me at Bayer Corporation at fax number (203) 812-5492.

- 3). The application and declaration were sent to Dr. Lam via Federal Express (International Priority) on 13 June 2002.
- 4) The Federal Express package was tracked over the period 13 June 2002 - 20 June 2002.
- 5) Federal Express attempted to deliver the package on 17 June 2002, but without success. The tracking records indicate that the package was returned on 20 June 2002. The returned package was received in this office on 21 June 2002.
- 6) The Federal Express Tracking records are appended to this declaration.
- 7) On 7 June 2002 I requested Cecilia Scully, Sr. Information Scientist, Bayer Corporation to perform all appropriate computer data base and internet searching in an attempt to locate Dr. Lam.
- 8) Ms. Scully searched a variety of databases and employed a number of Internet search engines, as shown by the attachments to the accompanying declaration of Cecilia Scully.
- 9) Ms. Scully's computerized searching did not result in locating Dr. Lam.

Respectfully submitted,

Reg. No. 31018
Phone: (203) 812-2712
Date: 3 July '02



William F. Gray
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516-4175



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Cheung, et al.
Serial No: 09/743,827
Filed: 17 July 1999
For: Antiparasitic Artemisinin Derivatives (Endoperoxides)

Group Art Unit:
Examiner:

CERTIFICATION OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence and any papers referred to as attached are being deposited, on the date shown below, with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231.

Date:

Eugenia Boshnack
Eugenia Boshnack

**DECLARATION OF CECILIA SCULLY IN SUPPORT OF A FILING ON BEHALF OF
NON-SIGNING INVENTOR UNDER 37 CFR § 1.47(a)**

**Commissioner for Patents and Trademarks
Washington, DC 20231**

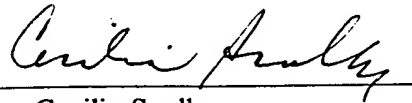
Sir:

I, Cecilia Scully, Sr. Information Scientist at Bayer Corporation, 400 Morgan Lane, West Haven, CT 06516, hereby declare and state that:

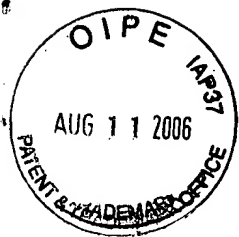
- 1.) On 7 June 2002 Bayer Patent Counsel William F. Gray requested that I conduct computer searching of appropriate databases and use appropriate Internet search engines, to locate Dr. William Wai-Lun Lam.
- 2.) My search strategies and the results thereof are set forth in the accompanying memo to Dr. Gray and the associated attachments.
- 3.) The searching I conducted did not locate Dr. Lam.

4.) I also had Larry Anderson, Sr. Scientist 1 (a searcher employed by the Bayer Library), conduct searching in the Micropatent database for patent applications in which Dr. Lam is listed as an inventor. The results of this searching did not identify Dr. Lam's current address.

Date: 7/3/02



Cecilia Scully
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516-4175



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Cheung, et al.
Serial No: 09/743,827
Filed: 17 July 1999
For: Antiparasitic Artemisinin Derivatives (Endoperoxides)

Group Art Unit:
Examiner:

CERTIFICATION OF MAILING UNDER 37 C.F.R. 1.8(a)

I hereby certify that this correspondence and any papers referred to as attached are being deposited, on the date shown below, with the United States Postal Service, with sufficient postage, as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231.

Date:

Eugenia Boshnack
Eugenia Boshnack

**DECLARATION OF LARRY ANDERSON IN SUPPORT OF A FILING ON BEHALF
OF NON-SIGNING INVENTOR UNDER 37 CFR § 1.47(a)**

**Commissioner for Patents and Trademarks
Washington, DC 20231**

Sir:

I, Larry Anderson, Sr. Scientist 1 and search consultant at Bayer Corporation, 400 Morgan Lane, West Haven, CT 06516, hereby declare and state that:

- 1.) In connection with a search requested by Dr. William F. Gray to attempt to identify the address of Dr. William Wai-Lun Lam, Ms. Cecilia Scully requested that I search the Micropatent database for patent applications in which Dr. Lam might be listed as an inventor.
- 2.) This searching identified several application in which Dr. Lam is listed as an inventor, but the records retrieved indicate his previous affiliation with the Hong Kong University of Science and Technology.
- 3.) The search of the Micropatent database did not identify Dr. Lam's current affiliation or address.

4) The printout of the search results from the Micropatent database search are among the attachments accompanying the declaration of Cecilia Scully on this matter.

Larry Anderson
Larry Anderson
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516-4175

Date: 7/3/02

20 SEP 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Jeffrey M. Greenman
Vice President, Patents and Licensing
Bayer Corporation
400 Morgan Lane
West Haven, CT 06516

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SEP 26 2002

CAROL G. BRUNN

In re Application of
CHEUNG, et al.
U.S. Application No.: 09/743,827
PCT No.: PCT/GB99/02267
Int. Filing Date: 14 July 1999
Priority Date: 14 July 1998
Attorney Docket No.: LEA33820
For: ANTIPARASITIC ARTEMISININ
DERIVATIVES (ENDOPEROXIDES)

DECISION ON RENEWED

PETITION UNDER

37 CFR 1.47(a)

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 08 July 2002 in the United States Patent and Trademark Office (USPTO) and supplemented 12 August 2002.

BACKGROUND

On 04 December 2001, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a). Applicant was afforded two months to file any request for reconsideration and advised that this period was extendable with a proper petition and fee.

On 08 July 2002, applicant filed the current renewed petition accompanied by a petition for a five month extension of time and payment of the extension fee. Applicant has certified that the papers were deposited for mailing on 03 July 2002; accordingly, applicant's renewed petition is considered timely filed.

DISCUSSION

As detailed in the decision mailed 04 December 2001, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant previously satisfied items (1), (3) and (4).

With the filing of the present renewed petition and accompanying declaration, applicant has satisfied all four items and it is appropriate to grant the petition under 37 CFR 1.47(a). Specifically counsel, having first-hand knowledge of the attempt to locate the non-signing inventor, has certified that the envelopes containing a complete set of application papers and declaration were returned as undeliverable. In addition, applicant has provided declarations from Cecilia Scully and Larry Anderson detailing their efforts to locate a current address for inventor LAM using various search engines and databases. In light of the above, it is proper to **GRANT** applicant's petition at this time. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have now been satisfied.

CONCLUSION

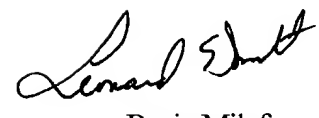
Applicant's renewed petition under 37 CFR 1.47(a) is **GRANTED**.

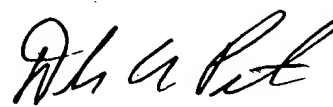
As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application will be given an international application filing date of 14 July 1999 and a date of **31 July 2001** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a NOTIFICATION OF ACCEPTANCE UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903).


Boris Milef
Legal Examiner
PCT Legal Office


Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459



BEATRIZ ALVIZ
LAW & PATENTS
C32-3B
BAYER CORPORATION
400 MORGAN LANE
WEST HAVEN, CT 06516

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The U.S. Patent & Trademark Office date stamp hereon will acknowledge receipt of the following in Re the application of Haynes, et al., Serial No.: 09/743,827, filed: 01/16/2001, entitled "Antiparasitic Artemisinin Derivatives (Endoperoxides)":

- Petition and Fee for Five Months Extension of Time [IN DUPLICATE];
- Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing under 35 U.S.C. 371 [IN DUPLICATE];
- Copy of Notification of Missing Requirements;
- Original Combined Declaration and Power of Attorney;
- Petition, Fee, and Statement of Facts Supporting a Filing of Behalf of Non-signing Inventor (37 C.F.R. § 1.47(a)) [IN DUPLICATE];
- Declaration of Richard Haynes in Support of Filing on Behalf of Non-Signing Inventor (37 C.F.R. § 1.47(a));
- Preliminary Amendment; and
- Return Receipt Post Card.

Date of Deposit: JUL 24 2001
First Class Mail

Le A 33 820
JLC/ba

JC20 Rec'd PCT/PTO 3 1 JUL 2001